



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,551	02/16/2001	Petter Ericson	64242	3125

7590 01/12/2005

NORMAN H. ZIVIN
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

SAID, MANSOUR M

ART UNIT	PAPER NUMBER
----------	--------------

2673

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,551

Applicant(s)

ERICSON ET AL.

Examiner

MANSOUR M SAID

Art Unit

2673

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,16,22-27,31 and 44-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16,24-27,31 and 44-71 is/are allowed.
- 6) ☒ Claim(s) 1,2,22,23,72 and 73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. **This Office Action is in response to the amendment filed on 08/09/ 2004, and new claims (72-73) have been added.**

Claim Objections

2. **Claim 73 is objected to because of the following informalities: In claim 73, line 10, the phrase "at lest" should be changed to --at least--. Appropriate correction is required.**

Claim Rejections - 35 USC § 103

3. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2, 22-23 and 72-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Flores et al. (6310988 B1; hereinafter referred to as Flores).**

As to claim 1, Chan teaches an absolute position-coding pattern (absolute motion digital codes) in order to cause an input unit arrangement preferably with a mouse function mode to characterized in that the input unit arrangement is arranged to switch from a first (pen input

Art Unit: 2673

mode) to a second function (pen input mouse) (column 8, lines 1-19; column 11, lines 48-63 and column 13, line 66 through column 14, line 4).

Chan does not expressly disclose an input device with an image recording that a signal-processing device detects a predetermined position-coding pattern in one of the images.

However, Flores teaches an input device with an image recording that a signal-processing device detects a predetermined position-coding pattern in one of the images (figures 17-22; 27 & 28; column 11, lines 30-62; column 14, lines 33-67 and column 15, lines 9-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Flores's camera pen into Chan's system so as to capture a user selected portion on the glyph address carpet (column 11, lines 31-33).

As to claims 2 and 73, Chan teaches an absolute position-coding pattern (absolute motion digital codes) in order to cause an input unit arrangement preferably with a mouse function mode to characterized in that the input unit arrangement is arranged to switch from a first (pen input mode) to a second function (pen input mouse) (column 8, lines 1-19; column 11, lines 48-63 and column 13, line 66 through column 14, line 4).

Chan does not expressly disclose the signal-processing device detects a different pattern to the predetermined position-coding pattern in one of said images.

However, Flores teaches the signal-processing device detects a different pattern to the predetermined position-coding pattern in one of said images.

(figures 17-22; 27 & 28; column 11, lines 30-62; column 14, lines 33-67 and column 15, lines 9-25).

Art Unit: 2673

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Flores's camera pen into Chan's system so as to capture a user selected portion on the glyph address carpet (column 11, lines 31-33).

function mode when

As to claim 22, Chan teaches an absolute position-coding pattern (absolute motion digital codes) in order to cause an input unit arrangement preferably with a mouse function mode to characterized in that the input unit arrangement is arranged to switch from a first (pen input mode) to a second function (pen input mouse) (column 8, lines 1-19; column 11, lines 48-63 and column 13, line 66 through column 14, line 4).

Chan does not expressly disclose an input device with an image recording that a signal-processing device detects a predetermined position-coding pattern in one of the images.

However, Flores teaches an input device with an image recording that a signal-processing device detects a predetermined position-coding pattern in one of the images (figures 17-22; 27 & 28; column 11, lines 30-62; column 14, lines 33-67 and column 15, lines 9-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Flores's camera pen into Chan's system so as to capture a user selected portion on the glyph address carpet (column 11, lines 31-33).

As to claim 23, Flores teaches that the signal-processing device is designed to process the images to achieve at least one of the functions (figure 17; column 11, lines 43-62 and column 14, lines 55-65).

As to claim 72, Chan teaches an absolute position-coding pattern (absolute motion digital codes) in order to cause an input unit arrangement preferably with a mouse function mode to

Art Unit: 2673

characterized in that the input unit arrangement is arranged to switching from the input function mode to the mouse function mode (column 8, lines 1-19; column 11, lines 48-63 and column 13, line 66 through column 14, line 4).

Chan does not expressly disclose capturing a plurality of images; processing the captured images; determining that at least one of the captured images includes a predetermined position-coding pattern.

However, Flores teaches capturing a plurality of images (figures 27-28, column 11, lines 30-55, column 14, lines 55-65 and column 19, lines 20-45); processing the captured images (figures 27-28, column 11, lines 30-55, column 14, lines 55-65 and column 19, lines 20-45); determining that at least one of the captured images includes a predetermined position-coding pattern; (figures 17-22; 27 & 28; column 11, lines 30-62; column 14, lines 33-67 and column 15, lines 9-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Flores's camera pen into Chan's system so as to capture a user selected portion on the glyph address carpet (column 11, lines 31-33).

Allowable Subject Matter

5. **Claims 16, 24-27, 31 and 44-71 are allowed.**

Response to Arguments

6. Applicant's arguments filed 8/9/04 have been fully considered but they are not persuasive. On pages 14-15, Applicant argued that "there is no teaching or suggestion in Chan et

Art Unit: 2673

al. that is directed to the pen input itself being able to switch between modes nor is there any teaching or suggestion of an absolute position coding pattern ... there is no teaching or suggestion that is directed to switching modes when the signal-processing device detects a predetermined position-coding pattern in one of the images”.

Examiner respectfully disagrees for the following reasons, Chan fairly teaches that the pen input itself being able to switch between modes (pen input mode/mouse mode) (column 8, lines 1-16), and absolute position coding pattern (absolute motion digital codes) (column 8, lines 1-16 and column 13, line 61 through column 14, line 4), and Flores fairly discloses that the signal-processing device detects a predetermined position-coding pattern in one of the images (column 11, 30-62, column 14, lines 33-67 and figures 17, 21 & 27-28). The combination of Chan and Flores fairly disclose the claimed limitations, and therefore both references should be taken in combination and not individually. **The Applicant cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In re Keller, 208 USPQ 871 (CCPA 1981).**

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hugosson et al. (2003/0046256 A1) teach a user unit records electronically information, which comprises one or more positions on the imaginary surface, and send all or parts of the recorded information.

Art Unit: 2673

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS OFFICE ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mansour M. Said** whose telephone number is **(703) 306-5411**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(703) 305-4938**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Art Unit: 2673

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office whose telephone number is (703) 306-0377.

1/3/2005

Mansour M. Said


BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600